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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,040	12/15/1999	Michelle Q. Wang Baldonado	104323	3267

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Oliff & Berridge PLC  
PO Box 19928  
Alexandria, VA 22320

EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,040

Applicant(s)

BALDONADO ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-37 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This action is responsive to communications: Amendment filed 01/14/2005 to the original application filed 12/15/1999.
2. Claims 1-37 are currently pending in this application. Claims 12 and 23 have been amended. Claims 1, 14 and 26 are independent claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

**Eberman et al.** (U.S. 6,173,287 – filed 03/1998) in view of **Schilit et al.** “Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations”, published 04/1998, cited previously by Applicant’s IDS.

**As to independent claim 14:**

- a. Eberman discloses a method for associating annotations with at least one object  
*(e.g., an annotation of interest corresponding to the item of interest; col.2, lines 16-24) comprising:*
  - (i) searching for the at least one object to annotate *(e.g., Once the annotation of interest has been found; col.2, lines 46-59);*
  - (ii) obtaining an object identifier for at least one object *(e.g., each object in the meta database ...along with ,or with reference to, each associated object identification number; col.20, lines 61-65 /obtains the object identification number ... object type; col.21, lines 15-29);*
  - (iii) establishing a link associating the at least one annotation with the object *(col.16, lines 1-10 and Fig.7);*
  - (iv) transferring the at least one annotation to the at least one object by associating the at least one annotation with the at least one object based on the link and the at least one object identifier *(e.g., the location identifier can be identified in conjunction with the locating of the annotation of interest ... the search identifier is preferably an object identifier ...the stored address identifiers are URLs identifying the locations of digital representations within one or more databases; col.3, lines 13-54 and Fig.9).*
- b. Eberman discloses generating at least one annotation using an annotation device  
*(e.g., The annotation client 18 ... generate annotations for the object; col.7, lines*

19-34 and Fig. 1A), but does not explicitly disclose “a viewing device that is distinct from the annotation device.”

- c. Schilit discloses a viewing device that is distinct from the annotation device (*page 1 & Fig. 1*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Schilit in the system of Eberman because it would have provided the capability for improving reading with computation have focused on creating new media- hypertext or hypermedia that define the document being read as well as the act of reading, placing them in a separate world from existing books and paper documents (*page 255, left column, last para.*).

**As to dependent claim 15:**

Eberman discloses the annotation linking circuit establishes the link to the at least one portion based on at least one of a graphical technique and a textual technique (*col.2, lines 24-38*).

**As to dependent claim 16:**

Eberman discloses the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object (*col.2, lines 24-38*).

**As to dependent claim 17:**

Eberman discloses the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text (*col.2, lines 24-38*).

**As to dependent claim 18:**

Eberman discloses the textual technique is based on a phrase completion technique  
(*col.22, line 23-col.23, line 67*).

**As to dependent claim 19:**

Eberman discloses associating the object identifier and the at least one object (*col.2, lines 16-45*).

**As to dependent claim 20:**

Eberman discloses retrieving supplemental information associated with the at least one object (*Abstract*).

**As to dependent claim 21:**

Eberman discloses developing a digital surrogate of the at least one object (*col.2, lines 16-45*).

**As to dependent claim 22:**

Eberman discloses retrieving at least one previous annotation associated with the at least one object (*col.3, lines 9-34*).

**As to dependent claim 23:**

Eberman discloses annotating at least one object while the annotation object is decoupled from the object

**As to dependent claim 24:**

Eberman discloses searching for the at least one object comprises: entering at least one of a description of the object and the object identifier; and searching at least one of a

networked search engine, a personal computer and a distributed network (*col.2, line 24-col.3, line 34 & col.4, lines 44-65*).

**As to dependent claim 25:**

Eberman discloses the at least one object is at least one of a media type object, a device type object, a location type object and a digital document (*Figs. 8-9*).

**As to independent claim 26:**

It is directed to an information storage media for implementing the method of claim 14, and is similarly rejected under the same rationale.

**As to dependent claims 27-30 and 31-37:**

They include the same limitations as in claims 15-18 and 20-25, and are similarly rejected under the same rationale.

**As to independent claim 1:**

The rejection of claim 14 above is incorporated herein in full. Additionally, Eberman further discloses:

- (i) a database that stores an object identifier, the at least one annotation and the link (*e.g., The search identifier and the location identifier are stored with the annotation of interest in a database; col.3, lines 9-54*); and
- (ii) a synchronize circuit that associates the at least one annotation with the at least one portion of the object based on the link and the object identifier (*Fig.9 and associated text*).

**As to dependent claims 2-5:**

They include the same limitations as in claims 15-18, and are similarly rejected under the same rationale.

**As to dependent claim 6:**

Eberman discloses the search circuit is located in at least one of the annotation device, a personal computer and a networked search engine (*col. 4, lines 44-65*).

**As to dependent claim 7:**

Eberman discloses the search circuit receives at least one of the object identifier and one or more key words corresponding to the object to be annotated (*col.2, line 25- col.3, line 34*).

**As to dependent claim 8:**

Eberman discloses an annotation database that stores the at least one annotation and the object identifier for the at least one object (*col.2, lines 16-45*).

**As to dependent claim 9:**

Eberman discloses the annotation database is located on a distributed network (*Figs.1A&1B*).

**As to dependent claim 10:**

Eberman discloses the annotation database stores at least one annotation previously associated with the at least one object (*col.7, lines 19-67*).

**As to dependent claim 11:**

It includes the same limitations as in claim 25, and is similarly rejected under the same rationale.

**As to dependent claim 12:**



- a. Eberman does not explicitly disclose “*the annotation device is a portable personal digital assistant, which can be decoupled from the object when the annotation is made.*”
- b. Schilit discloses the annotation device is a portable personal digital assistant, which can be decoupled from the object when the annotation is made (*page 252, left column, 1<sup>st</sup> para.*).
- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Schilit in the system of Eberman because it would have provided the capability for improving reading with computation have focused on creating new media- hypertext or hypermedia that define the document being read as well as the act of reading, placing them in a separate world from existing books and paper documents (*page 255, left column, last para.*).

**As to dependent claim 13:**

Eberman discloses the object identifier is collocated with the at least one object (*col.2, line 39- col.3, line 34*).

***Response to Arguments***

4. Applicants’ arguments with respect to claims 01/14/2005 have been considered but they are not persuasive.
  - a. Applicant argues that *nowhere in Schilit or Eberman is such a motivation expressed.* (Remarks, 2<sup>nd</sup> para., page 9)

- b. In response, the motivation for the combination is suggested by Schilit (*see page 255, left column, last para.*).
- c. Applicant argues that *it is apparent that Office Action is relying on impermissible hindsight gained from Applicant's disclosure.* (Remarks, 1<sup>st</sup> para., page 10)
- d. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

- 5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DeRose et al.            U.S. Patent No. 6,105,044            issued: Aug. 15, 2000

- 6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
May 13, 2005

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
5/16/2005